

REMARKS

Claims 16-44 are pending in the application before entry of this amendment. Claims 32-37 have been withdrawn from consideration due to a restriction requirement. The Office has also declined to examine claims 38-44. By way of this amendment, claims 16, 22, and 23 have been amended, claims 17 and 32-37 have been canceled, and no claims have been newly added. No new matter has been added.

The pending objection and rejections will be addressed below.

Status of Claims

By way of Restriction Requirement mailed September 28, 2010, the then pending claims were classified into three groups:

- I. Claims 17, 22, 23-27, drawn to compounds of formula I wherein $n=2$ piperidinyl compounds, classified in class 546, subclass various, pending on species election
- II. Claims 16, 18-21, 29-31 remaining compounds drawn to compounds of formula I wherein $n=1$, pyrrolidinyl compounds, classified in class 548, subclass various, depending on species election.
- III. Claims 32-37, drawn to method of treating psychotic disorder, depression, mood disorder, anxiety or rheumatoid arthritis.

Of note, independent claims 16 (from which claim 17 depended) and 23 recited solvates of the claimed compounds. So, necessarily, either the Office's definition of group I included the recited solvates or the recited solvates were omitted from the Restriction Requirement. In other words, the solvates of the compounds of formula I wherein $n=2$ piperidinyl compounds are either included in group I or were not restricted. In either circumstance, they are still properly under consideration for examination.

By response of November 23, 2010, Applicants elected to prosecute the claims as classified in group I, i.e. compounds of formula I wherein $n=2$, and added new claims 38-44 wherein each of the added claims fell within the genus of group I, each of the added claims was of the same statutory class as group I, and one or more of the added claims recites solvates as was present within the genus of the claims of group I at the time of restriction.

The Office Action states that newly added claims 38-44 are withdrawn. There is no statutory basis, regulatory basis, or basis in the MPEP provided for the refusal to examine the newly added claims. Notably, the Office does not argue that the claims recite a different invention from the elected group I.

Applicants request that claims 38-44 be examined, as they are part of previously elected group I. If the Office declines to examine claims 38-44, Applicants respectfully request that the Office provide the statutory or regulatory basis upon which it bases its refusal/rejection so that Applicants' rights to appeal are not prejudiced.

Claims 16 and 23 have been amended to remove recitation of solvates. Claims 32-37 have been canceled as non-elected subject matter.

Claim Rejections Under 35 USC 112, First Paragraph

Claims 16-22 and 23-24, 29 are rejected under 35 USC 112, first paragraph, based on recitation of solvates. In order to expedite prosecution, claims 16 and 23 (and, by dependency, the remainder of the pending and rejected claims) have been amended to remove recitation of solvates. Applicants submit that the amendment has overcome the rejection.

Claims 38-44 contain recitations of solvates and/or hydrates. Each of claims 38-44 is drawn to the compound 1-[(3,5-Dichlorophenyl)methyl]-3-[4-(4-fluorophenyl)-4-piperidinyl]-1,5-dihydro-2H-pyrrol-2-one or a pharmaceutically acceptable salt or a solvate thereof. The claimed salts, solvates, and hydrates are specifically described and enabled in the specification. See, for instance, examples 3, 4, 50, 51, 52, and 53.

Claim Objections

Claims 25-28, 30-31 are objected to as being dependent upon a rejected base claim. Claim 25 is an independent claim that is not rejected, and claims 26 - 28 depend on claim 25. It is unclear which, if any, rejection the Office is referring to. Without any underlying rejection, Applicants submit that claims 25-28 are allowable.


Claims 30 and 31 depend from claim 29 which depends from claim 1. The rejection with regard to claim 1 has been addressed and overcome such that claims 30 and 31 should be allowable.

Conclusion

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge any fees or credit any overpayment, particularly including any fees required under 37 CFR Sect 1.16 or 1.17, and any necessary extension of time fees, to deposit Account No. 07-1392.

Applicants respectfully submit that the instant application is in condition for allowance, which action is respectfully requested. The Examiner is invited to contact the undersigned at (919) 483-8160, to discuss this case, if desired.

Respectfully submitted,


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